Supreme Court, U.S.
FILED
JUN 23 2005
OFFICE OF THE CLERK

No. 04-1738

In The

Supreme Court of the United States

NANCEY SILVERS.

Petitioner,

v.

SONY PICTURES ENTERTAINMENT, INC.,

Respondent.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Ninth Circuit

PETITION FOR WRIT OF CERTIORARI

STEVEN GLASER, ESQ.
GELFAND RAPPAPORT & GLASER, LLP
11111 Santa Monica Boulevard, Suite 1000
Los Angeles, California 90067
Telephone: (310) 477-7446
Fax: (310) 473-0906

Counsel for Petitioner

COCKLE LAW BRIEF PRINTING CO (800) 225-6964
OR CALL COLLECT (402) 342-2831

QUESTIONS PRESENTED

1. Whether Section 501(b) of the 1976 Copyright Act prohibits the assignment of an accrued cause of action for copyright infringement to the original author of a work where the assignor retains all other rights under the copyright; and, if so,

2. Whether joinder of the copyright owner as a party to the litigation pursuant to FRCP Rule 19(a) to foreclose the risk of duplicative suits is an appropriate remedy.

LIST OF PARTIES

Petitioner is Nancey Silvers.

Respondent is Sony Pictures Entertainment, Inc., a Delaware corporation ("Sony").

Additional party defendants in this case are Wendy Finerman Productions, Inc., a California corporation; Wendy Finerman; 1492 Films, Inc., a California corporation; Chris Columbus; Mark Radcliffe; Michael Barnathan; Patrick McCormick; Ron Bass; Margaret French Isaac; Gigi Levangie; Julia Roberts; Susan Sarandon; and Pliny Porter.

TABLE OF CONTENTS

	Page
QUESTIONS PRESENTED	i
LIST OF PARTIES	ii
TABLE OF CONTENTS	iii
TABLE OF AUTHORITIES	v
PETITION FOR WRIT OF CERTIORARI	1
OPINION BELOW	1
JURISDICTION	1
RELEVANT STATUTORY PROVISIONS	2
1. 17 U.S.C. § 501(B)	2
2. Federal Rules of Civil Procedure, Rule 19(a)	2
STATEMENT OF THE CASE	3
REASONS FOR GRANTING THE WRIT	4
LEGAL DISCUSSION	7
I. THERE IS A SPLIT AMONG THE CIRCUITS ON AN IMPORTANT QUESTION OF FEDERAL LAW. THE CIRCUIT SPLIT FRUSTRATES CONGRESS' GOAL OF ENHANCING PREDICTABILITY AND CERTAINTY OF COPYRIGHT OWNERSHIP	7
II. THE NINTH CIRCUIT'S DECISION CREATES UNCERTAINTY OVER THE ABILITY OF A COPYRIGHT OWNER TO ALIENATE PROPERTY	10

TABLE OF CONTENTS – Continued

Page

III. THE NINTH CIRCUIT'S DECISION CONFLICTS WITH ESTABLISHED CASE LAW PROVIDING FOR JOINDER OF THE COPYRIGHT OWNER AS THE APPROPRIATE REMEDY FOR A STANDING PROBLEM OF THIS NATURE 15

CONCLUSION 16

TABLE OF AUTHORITIES

Page

CASES

ABKCO Music, Inc. v. Harrisongs Music, Ltd., 944 F.2d 971 (2nd Cir. 1991) 6, 7, 10, 11

Community for Creative Non-Violence v. Reid, 490 U.S. 730 (1989) 7

Co-Opportunities, Inc. v. National Broadcasting Company, Inc., 510 F. Supp. 43 (N.D. Cal. 1981) 11

De Silva Construction Corp. v. Herrald, 213 F. Supp. 184 (M.D. Fla. 1962) 11

Ed Brawley, Inc. v. John Gaffney, Etc., Inc., 399 F. Supp. 115 (N.D. Cal. 1975) 11

Eden Toys, Inc. v. Florelee Undergarment Co., Inc., 697 F.2d 27 (2d Cir. 1982) 7

First Financial Marketing Services Group, Inc. v. Field Promotions, Inc., 286 F. Supp. 295 (S.D.N.Y. 1968) 15

Gardner v. Nike, Inc., 279 F.3d 774 (9th Cir. 2002) 8

Independent Wireless Telegraph Co. v. Radio Corporation of America, 269 U.S. 459 (1926) 15

Infodek, Inc. v. Meredith-Webb Printing Company, Inc,. 830 F. Supp. 614 (N.D. Ga. 1993) 11

Intellectual Property Development, Inc. v. TCI Cablevision of California, Inc., 248 F.3d 1333 (Fed. Cir. 2001) 15

Intimo, Inc. v. Briefly Stated, Inc., 948 F. Supp. 315 (S.D.N.Y. 1996) 11

Parfums Givenchy, Inc. v. C & C Beauty Sales, Inc., 832 F. Supp. 1378 (C.D. Cal. 1993) 11

TABLE OF AUTHORITIES – Continued

Page

Prather v. Neva Paperbacks, Inc., 410 F.2d 698 (5th Cir. 1969) ..... *passim*

Sabroso Publishing, Inc. v. Caiman Records America, Inc., 141 F. Supp. 2d 224 (D.C. P.R. 2001)..... 11

STATUTES

Federal Rules of Civil Procedure, Rule 17..... 8

Federal Rules of Civil Procedure, Rule 19(a) 2, 15

17 U.S.C. § 101(b) (1909)..... 8

17 U.S.C. § 106A..... 9

17 U.S.C. § 501(b)..... *passim*

28 U.S.C. § 1338(a)..... 1

28 U.S.C. § 1254(1)..... 1

TREATISES

Nimmer on Copyright (§ 12.02[B], p. 12-54 (1999).)..... 4, 15

PETITION FOR WRIT OF CERTIORARI

Petitioner Nancey Silvers respectfully petitions for a writ of certiorari to review the en banc decision of the Ninth Circuit Court of Appeals in this case filed on March 25, 2005.

OPINION BELOW

The en banc opinion of the United States Court of Appeals for the Ninth Circuit is published at 402 F.3d 881 (9th Cir. 2005) and is reprinted in the Appendix to this petition at pages 1-62. The district court's order denying Sony's motion to dismiss was not published and is reprinted in the Appendix at pages 63-69. The original panel's opinion superseded by the en banc decision was published at 330 F.3d 1204 (9th Cir. 2003) and is reprinted in the Appendix at pages 70-78. The Ninth Circuit's order taking the case en banc is published at 370 F.3d 1252 and is reprinted in the Appendix at page 79.

JURISDICTION

The United States District Court had jurisdiction over this action for copyright infringement pursuant to 28 U.S.C. § 1338(a). The United States Court of Appeals for the Ninth Circuit filed its opinion on March 25, 2005. Supreme Court jurisdiction is invoked pursuant to 28 U.S.C. § 1254(1).

RELEVANT STATUTORY PROVISIONS

1. 17 U.S.C. § 501(b):

"The legal or beneficial owner of an exclusive right under a copyright is entitled, subject to the requirements of section 411, to institute an action for any infringement of that particular right committed while he or she is the owner of it. The court may require such owner to serve written notice of the action with a copy of the complaint upon any person shown, by the records of the Copyright Office or otherwise, to have or claim an interest in the copyright, and shall require that such notice be served upon any person whose interest is likely to be affected by a decision in the case. The court may require the joinder, and shall permit the intervention, of any person having or claiming an interest in the copyright."

2. Federal Rules of Civil Procedure, Rule 19(a):

"A person who is subject to service of process and whose joinder will not deprive the court of jurisdiction over the subject matter of the action shall be joined as a party in the action if (1) in the person's absence complete relief cannot be accorded among those already parties, or (2) the person claims an interest relating to the subject of the action and is so situated that the disposition of the action in the person's absence may (i) as a practical matter impair or impede the person's ability to protect that interest or (ii) leave any of the persons already parties subject to a substantial risk of incurring double, multiple, or otherwise inconsistent obligations by reason of the claimed interest. If the person has not been so joined, the court shall order that the person be made a party. If the person should join as a plaintiff but refuses to do so, the

person may be made a defendant, or, in a proper case, an involuntary plaintiff. If the joined party objects to venue and joinder of that party would render the venue of the action improper, that party shall be dismissed from the action."

STATEMENT OF THE CASE

This petition seeks review of a decision by the United States Court of Appeals for the Ninth Circuit holding that Section 501(b) of the 1976 Copyright Act (17 U.S.C. § 501(b)) prohibits the assignment of an accrued cause of action for copyright infringement to the original author of a work where the assignor retains all other rights under the copyright.

Petitioner Nancey Silvers wrote the script for a made-for-television movie called *The Other Woman*. Silvers completed the script as a work-for-hire for Frank & Bob Films II, aka Von Zerneck/Sertner Films, which owns the copyright. Three years after *The Other Woman* aired on network television, Sony released the motion picture *Stepmom*. Silvers believed that *Stepmom* was copied from her work and obtained from Frank & Bob Films a written Assignment of Claims and Causes of Action. Although it retained ownership of the copyright to *The Other Woman*, Frank & Bob Films expressly assigned to Silvers "all right, title and interest in and to any claims and causes of action against Sony Pictures Entertainment, Inc., Columbia TriStar, and any other appropriate persons or entities, with respect to the screenplay '*The Other Woman*' . . . and the motion picture '*Stepmom*.'" (App. at 2.)

Silvers then filed an action against Sony (and others) for copyright infringement. Sony moved to dismiss on the ground that Silvers lacked standing. The district court denied the motion (App. at 63-69) and certified the issue for interlocutory appeal. The original Ninth Circuit panel unanimously affirmed the district court's order. (App. at 70-78.) The Ninth Circuit then voted to take the case en banc. (App. at 79.) Ultimately, a majority of seven judges of the en banc court reversed the district court's ruling, and four judges filed two separate dissents. (App. at 1-62.)

REASONS FOR GRANTING THE WRIT

The Ninth Circuit's majority opinion directly conflicts with a prior ruling by the Fifth Circuit on the same issue. In *Prather v. Neva Paperbacks, Inc.*, 410 F.2d 698 (5th Cir. 1969), the court held that the assignee of an accrued copyright infringement cause of action had the right to maintain a suit regardless of whether the assignee was the copyright "proprietor." The Fifth Circuit held there was no public policy against such assignments and viewed the issue as a "simple assignment of a chose in action" requiring only that "the contract cover in no uncertain terms choses in action for past, prior accrued damages." (*Id.* at 699-700.) At the time this case was filed, *Nimmer on Copyright* relied on *Prather* for the following proposition:

> [T]he assignee of an accrued cause of action has standing to sue without the need to join his assignor, even if the latter retains ownership of all other rights under the copyright. (§ 12.02 [B], p.12-54 (1999).)

The Ninth Circuit majority in this case recognized that "the creation of a circuit split would be particularly troublesome in the realm of copyright" because it would frustrate "Congress' paramount goal in revising the 1976 Act of enhancing predictability and certainty of copyright ownership." The majority cautioned that inconsistent rules among the circuits would lead to different levels of protection in different areas of the country, even if the same infringement is occurring nationwide. (App. at 17-18.) Unfortunately, the Ninth Circuit misconstrued Section 501(b) and *Prather* and created the precise circuit split it warned against.

In addition to creating a split among circuits, the majority opinion casts doubt on the continued viability of a body of case law authorizing suits assigned to persons not specified in Section 501(b), and thereby creates uncertainty over whether and/or under what circumstances the owner of a copyright may assign an accrued infringement cause of action. The Ninth Circuit majority interpreted the following portion of Section 501(b) as carefully circumscribing, to the exclusion of all others, the only persons legally authorized to sue for infringement of a copyright (App. at 4-8):

> The legal or beneficial owner of an exclusive right under a copyright is entitled . . . to institute an action for any infringement ***of that particular right committed while he or she is the owner of it***. (Emphasis added.)

Logically, the majority's construction of Section 501(b) would preclude all assignments of copyright infringement claims because, by definition, the assignee would not be the owner of the right at the time infringement occurred. That interpretation conflicts with numerous cases, such as